

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 21, 25 and 26 will have been amended and resubmitted for consideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, and for the revised acknowledgment of Applicant's claim for priority under 35 U.S.C. § 119 and receipt, in the present application, of the certified copies of the priority documents, in the Official Action.

However, Applicant has also filed an Information Disclosure Statement in the present application on April 29, 2002. The Official Actions of March 14, 2005 and August 19, 2005 did not explicitly indicate the Examiner's consideration of the documents cited in this Information Disclosure Statement. The above-noted Information Disclosure Statement of April 29, 2002 cited several pending applications. Each of the pending applications has now issued as a patent. Accordingly, Applicant respectfully requests that the Examiner update his consideration thereof and confirm consideration of the patents. In this regard, U.S. Patent Application No. 09/077,290 is now U.S. Patent No. 6,426,946 while U.S. Patent Application No. 09/522,600 is now U.S. Patent No. 6,880,019.

For the convenience of the Examiner, Applicant has attached hereto a PTO-1449 Form listing the above-noted patents. To complete the record in the present application and to confirm consideration of the properly cited pending applications, the

Examiner is respectfully requested to initial the documents listed on the PTO-1449 Form and to forward a copy of the Form to Applicant together with the next communication in the present application.

Turning to the merits of the action, the Examiner has rejected claims 21, 25 and 26 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully traverses the above rejection and submits that the language of Applicant's claims is clear and properly descriptive of Applicant's invention.

In particular, claim 21, for example, recites a controller that is configured to transmit, to the scanner apparatus, a search packet. The search packet is further defined as being utilized to search for a scanner apparatus connectable to the terminal apparatus. It is not clear how or why this terminology renders unclear the meaning and metes and bounds of the invention. In other words, according to Applicant's invention as recited in the claims, the search packet transmitted to the scanner is utilized to search for a scanner apparatus connectable to the terminal apparatus.

Moreover, Applicant notes the existence of similar language in claim 17 which has not been rejected by the Examiner under 35 U.S.C. § 112, second paragraph. Accordingly, the basis for the Examiner's rejection is unclear. Nevertheless, by the present amendment, Applicant has amended claims 21, 25 and 26 to clarify the scope of the invention and address and resolve the Examiner's concerns. Thus, Applicant respectfully requests that the Examiner withdraw the rejection.

The Examiner has rejected claims 17, 21, 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over ROY et al. (U.S. Patent Publication No. 2002/0062366) in

view of ITOH (U.S. Patent Publication No. 2001/0021037). The Examiner has rejected claims 18 and 22 under U.S.C. § 103(a) as being unpatentable over ROY et al. and ITOH in view of KUMPH et al. (U.S. Patent No. 6,839,755). The Examiner has rejected claims 19-20 and 23-24 under 35 U.S.C. § 103(a) as being unpatentable over ROY et al. and ITOH in view of UHLER et al. (U.S. Patent Publication No. 2001/0021037).

As noted above, Applicant has amended claims 21, 25 and 26, and claims 17-26 thus remain pending for consideration by the Examiner. Applicant respectfully traverses the above rejection based on the pending claims 17-26 and will discuss the outstanding rejection with respect to these claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicant's claims 17-20 generally relate to a scanner apparatus which scans image data and includes an interface configured to be connected to a terminal apparatus via a network. The scanner apparatus includes a controller which receives, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus. The controller also transmits to the terminal apparatus a response to the search packet. The controller additionally receives, from the terminal apparatus, terminal information, the terminal information including an IP address of the terminal apparatus, after the response to search packet is transmitted to the terminal apparatus. The controller further transmits to the terminal apparatus the scanned image data, based on the IP address of the terminal apparatus included in the received terminal information. Claims 21-24 recite

related terminal apparatuses. Claim 25 recites a related system. Claim 26 recites a related method.

In direct contrast, ROY et al. relates to a system in which a HTTP client 15 sends an HTTP request to the management station 5, the management station 5 sends a DLP broadcast request to a plurality of SNMP agents 20, 25, 20, the management station 5 receives, from each of the plurality of the SNMP agents, a response to the DLP broadcast request, and the management station 5 sends the HTML list of devices to the HTTP client 15.

However, ROY et al. does not disclose a scanner apparatus which receives, from the terminal apparatus, a search packet, the search packet being utilized to search for a scanner apparatus connectable to the terminal apparatus, and transmits, to the terminal apparatus, a response to the search packet. In ROY et al., the Examiner appears to consider the HTTP client 15 to correspond to the terminal apparatus recited in, e.g., claim 17, and the SNMP Agent to correspond to the scanner apparatus recited in, e.g., claim 17. However, in ROY et al., the SNMP Agent receives, from the management station 5, the DLP broadcast request, but does not receive anything (and certainly not a search packet, as defined) from the HTTP client 15. Similarly, in ROY et al., the SNMP Agent sends, to the management station 5, a response to the DLP broadcast request, but does not send anything (and certainly not a response as defined) to the HTTP client 15. On the other hand, in the present invention, the scanner apparatus receives, from the terminal apparatus, the predetermined packet and transmits, to the terminal apparatus, a response to the predetermined packet. Further, regarding the HTML list of devices, management station 5 sends it to the HTTP client 15 (Fig. 1), but the SNMP

Agent does not send it to the HTTP client 15. Thus, claims 17-26 are clearly distinguished over ROY et al.

Therefore, it is respectfully submitted that the features recited in Applicants' submitted claims 17-26 are not disclosed in ROY et al. cited by the Examiner.

In setting forth the rejection, the Examiner admits that ROY et al. fails to disclose "receiving IP address from the terminal apparatus, and transmitting the scanned image to the terminal apparatus based on the scanned image data". The Examiner is incorrect. Applicant's claims do not recite the limitation noted by the Examiner. Rather, Applicant's claim recites, and ROY et al. fails to disclose, "transmitting the scanned image data to the terminal apparatus based on the IP address data".

The Examiner relies upon ITOH to disclose these features that are admittedly missing from ROY et al. However, ITOH does not, in fact, disclose these features.

ITOH relates to a network scanner apparatus which produces an image data signal, inputs an IP address of a transmitting destination of the image data signal (Fig. 7 S2 or S3), and transmits the image data signal to the terminal having the input IP address (Fig. 7 S9).

However, ITOH does not disclose a scanner apparatus which receives, from the terminal apparatus, terminal information, the terminal information including an IP address of the terminal apparatus, and transmits, to the terminal apparatus, the scanned image data, based on the IP address of the terminal apparatus included in the received terminal information. Rather, ITOH merely discloses a network scanner apparatus which directly inputs the IP address of the transmitting destination via the operation portion 1 of the network scanner apparatus (paragraph [0106]) and transmits

the image data signal to the terminal based on the IP address input via the operation portion 1 of the network scanner apparatus (paragraph [0114]). In other words, ITOH does not teach a scanner apparatus which receives terminal information from the terminal apparatus, and transmits the scanned image data to the terminal apparatus, based on information included in the received terminal information. Rather, in ITOH, the IP address of the transmitting destination is input via the operation portion 1 of the network scanner apparatus, but is not received from the transmitting destination (i.e., terminal apparatus). Thus, Applicant submits that the pending claims are clearly distinguished over ITOH.

Therefore, it is respectfully submitted that the features recited in Applicants' submitted claims 17-26 are not disclosed in ITOH cited by the Examiner. Claims 17-26 are also submitted to be patentable over the Examiner's proposed combination, since neither of ROY et al. and ITOH, nor any proper combination thereof, disclose the combination of features recited in Applicants' claims 17-26.

Moreover, the Examiner has set forth no proper motivation for the combination of ROY et al. and ITOH. In this regard, the Examiner asserted that motivation for the proposed combination would be based on eliminating the use of a server. However, eliminating the use of a server in ROY et al. would render the entire thing non-functional. In this regard, Applicant notes that the HTTP server of management station 5 is an essential component with respect to finding the desired network devices. In this regard, the Examiner's attention is respectfully directed to ROY et al., paragraph [0023].

Moreover, even if the proposed combination was motivated and serves the purpose of eliminating the server, the limitations and recitations of the present claims

would not be disclosed thereby. In this regard, Applicant notes that ITOH does not receive search packets from the terminal with the search packets being utilized to search for a scanner apparatus connectable to the terminal apparatus, at least since the terminal apparatus identification is (manually) input by the operation portion 1 of ITOH. Thus, even if the proposed combination were properly motivated, it would not meet the terms of Applicant's claims.

Moreover, ITOH does not disclose the features that the Examiner has asserted that it discloses. In particular, paragraph [0106] does not disclose receiving terminal information from the terminal. Rather, this paragraph merely indicates that the terminal address is directly input using operation portion 1. Similarly, paragraph [0114] does not disclose transmitting the scanned image data to the terminal apparatus "based on the IP address of the terminal apparatus included in the received terminal information" at least since no terminal information as recited is received in ITOH. Rather, paragraph [0114] discloses that the transmission portion 7 of the network scanning apparatus 100 utilizes the SMTP protocol obtained from the protocol control portion 8 (of the network scanner apparatus) using the IP address designated by the transmission requirement as a parameter. As noted previously, the IP address is designated via the operation portion 1 rather than as recited in Applicant's claims. Accordingly, ITOH does not disclose the features for which the Examiner relied thereupon.

For each of these reasons and certainly for all of these reasons, it is respectfully submitted that the Examiner's proposed rejection of any claims in the present application as unpatentable over any proper combination of ROY et al and ITOH is

inappropriate. Thus, reconsideration and withdrawal thereof is respectfully requested in due course.

The Examiner's rejection of claims 18 and 22 under 35 U.S.C. § 103 as unpatentable over ROY et al. and ITOH and further in view of KUMPF et al. is also traversed.

KUMPF et al. relates to a network peripheral server discovery method for discovering peripheral servers that a peripheral specific software can utilize.

However, KUMPF et al. does not disclose a scanner apparatus which transmits, to the terminal apparatus, the response to the search packet, when the identification information of the search packet matches identification information of the scanner apparatus. Rather, in KUMPF et al., the client 12 displays a list of peripherals 16 attached to the servers 10, and a user at the client 12 selects a peripheral, e.g., a scanner (col. 4, lines 47-63). In other words, the scanner apparatus does not transmit, to the client 12, a response to a predetermined packet, but the scanner is merely selected by the user at the client, via the list of peripherals displayed on the client 12. Thus, claims 18 and 22 are clearly distinguished over KUMPF et al.

Therefore, it is respectfully submitted that the features recited in Applicant's submitted claims 18 and 22 are not disclosed in KUMPF et al. cited by the Examiner. Claims 18 and 22 are also submitted to be patentable over the Examiner's proposed combination, since neither of ROY et al., ITOH, and KUMPF et al., nor any proper combination thereof, disclose the combination of features recited in Applicant's claims 18 and 22.

The Examiner's rejection of claims 19, 20, 23 and 24 under 35 U.S.C. § 103 as unpatentable over ROY et al. and ITOH in view of UHLER et al. is further traversed.

UHLER et al. relates to a method and apparatus for accessing a scanner on a network using HTTP. The client browser transmits, to the HTTP Scanner Server, a request for scanning the document in the scanner, and the HTTP Scanner Server determines whether the request is valid.

However, UHLER et al. does not disclose terminal information which the scanner apparatus receives from the terminal apparatus and includes an IP address of the terminal apparatus, since UHLER et al. merely discloses that the client browser transmits, to the HTTP Scanner Server, a request for scanning the document in the scanner and since UHLER et al. does not contain any disclosure about the recited terminal information. Thus, again UHLER et al. cannot overcome the shortcomings of KUMPF et al. Thus, pending claims 19-20 and 23-24 are clearly distinguished over UHLER et al.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 19-20 and 23-24 are not disclosed in UHLER et al. cited by the Examiner. Thus, pending claims are also submitted to be patentable over the Examiner's proposed combination, since even combination of ROY et al., ITOH and UHLER et al. does not disclose the combination of the features recited in Applicant's claims 19-20 and 23-24.

In setting forth the rejection based upon UHLER et al., the Examiner relies on paragraph [0062] of UHLER et al. for motivation. However, this paragraph does not even contain the motivation asserted by the Examiner. This paragraph deals with an

authentication server 206 and does not support the Examiner's assertion with respect to motivation.

Similarly, with respect to the Examiner's asserted motivation for the combination of features of KUMPF et al. with ROY et al. and ITOH, the Examiner relies upon column 4, lines 35-46. However, this portion of the KUMPF et al. disclosure merely indicates that after removing inappropriate servers from the data list, each remaining server is checked to determine that it contains the required firmware by sending an SNMP query. Accordingly, even the Examiner's basis for motivation does not support the combination of KUMPF et al. with the features of ITOH and ROY et al.

Regarding the motivation for the combination of ROY et al. and ITOH, the Examiner relies upon paragraph [0015] of ITOH. However, this paragraph merely describes the advantages of ITOH over the prior art and does not relate to any motivation or advantage of combining the teachings of ITOH with ROY et al.

Accordingly, none of the bases for motivation relied upon by the Examiner are adequate or sufficient to support the Examiner's position. Accordingly, each of the Examiner's rejections is inappropriate and each of Applicant's claims are clearly patentable over the prior art of record in the present application.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections, and requests an indication of the allowability of all the claims pending in the present application, in due course.

Although the status of the application is after final rejection, Applicant submits that entry of the amendment is proper under 37 C.F.R. § 1.116. In particular, no new issues are being presented. In particular, the only amendments made to the claims are

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to address the Examiner's rejection under 35 U.S.C. § 112, second paragraph and do not raise any new issues requiring further consideration or search. Rather, based upon the Examiner's rejection, these amendments clearly clarify the claims and place the same in better condition for allowance.

SUMMARY AND CONCLUSION


Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims to eliminate the 35 U.S.C. § 112 issue raised by the Examiner. With respect to the pending claims, Applicant has pointed out the features thereof and has contrasted the features of the claims with the disclosures of the applied references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

November 8, 2005
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